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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,919	08/07/2001	Michael David Bell	CM2034	1792

27752 7590 10/23/2003

THE PROCTER & GAMBLE COMPANY
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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/23/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,919

Applicant(s)

BELL ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-13 are pending. The Amendment filed 8/1/03, Paper No. 14, amended claim 1.

Applicant's arguments in the Amendment filed 8/1/03, Paper No. 14, are persuasive to overcome the 35 USC 112 rejections in the previous Office Action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/1/03 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shana (WO 94/03150) in view of Ilardi et al. (6,322,799) and in view of the Handbook of Cosmetic Science and Technology.

The instant invention is directed toward a composition comprising 6-20% polyhydric alcohol, a cation containing polymer selected from cationic, basic, amphoteric and zwitterionic polymers, and mixtures thereof, less than 4% of an anionic, zwitterionic or amphoteric

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surfactant, and 0.01-1% of C8-C24 mono, -di and -tri acyl sugar esters to the skin, and methods of applying these compositions to the skin.

Shana is directed to compositions intended for washing the human body (abstract) comprising applying the composition to the skin and hair. Taught is a composition comprising oily components, 1-50% non-ionic sugar based surfactant, and 0.001-2% water soluble cationic polymer, see pg. 9. Alkylpolyglycosides of the formula $RO-(G)_n$, wherein R is C5-C20, and G is glucose, xylose, lactose, fructose, mannose and derivatives thereof, are taught as sugar based surfactants, see pg. 5. The compositions can additionally comprise a polyol, preferably glycerol (see page 8, lines 30-32). Exemplified is a composition comprising alkyl polysaccharide 600, 10% glycerol and 5% guar hydroxy propyl tri-methyl ammonium chloride, see the examples in Table 1 at page 13. The compositions in Table 1 do not contain an anionic, zwitterionic or amphoteric surfactant. The reference lacks an exemplification of the instant invention wherein the sugar ester (the alkyl polysaccharide) comprises 0.01-1% of the composition and additional surfactants.

Ilardi et al. teach personal wash cleanser compositions. Liquid personal wash compositions are taught as comprising 1-20% anionics, 0.1-20% amphoteric/zwitterionic surfactants, and 0-10% nonionic surfactants, wherein acyl sugar esters are taught as nonionic surfactants. Anionic surfactants are taught as improving the lathering and solubility characteristics of personal wash cleanser compositions. See abstract; Col. 5, lines 9-23; Col. 9, line 44-Col. 10, line 17.

The Handbook of Cosmetic Science and Technology teaches that anionic surfactants produce a desirable combination of rich foam and excellent mildness and that they are also

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extraordinarily good hydrotropes and are remarkably compatible with a wide range of other surfactants, including some cationic conditioning agents. See page 222.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a composition of Shana wherein the alkyl polysaccharide comprises 0.01-1% of the composition because a) Shana teaches that the non-ionic sugar based surfactant (the alkyl polysaccharide) can comprise 1% of the composition; b) because Bardi et al. teach that the amount of nonionic surfactants, such as the alkyl polysaccharides taught by Shana, can be varied between 0-10% in washing compositions; c) because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the anionic surfactants taught by Bardi et al. into the compositions of Shana because of the expectation of achieving a cosmetic washing composition with improved lathering and solubility characteristics, a rich foam and excellent mildness.

Claims 11-13 are directed to a method of applying a composition comprising 6-20% polyhydric alcohol, a cation containing polymer, less than 4% of an anionic, zwitterionic or amphoteric surfactant, and 0.01-1% of C8-C24 acyl sugar esters to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product

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does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently moisturize the skin as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Response to Arguments

Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection. However, to the extent that the arguments may be relevant to the instant rejection, the Examiner will address them.

Applicant argues, "if one of skill in the art were searching for mild surfactants, he or she would not choose an anionic based on a reading of Shana's". This argument is not persuasive. First, the Examiner respectfully points out that the Handbook of Cosmetic Science and Technology teaches anionic surfactants as having excellent mildness. Second, it is respectfully pointed out that adding anionic surfactants in an amount of 1%, as taught by Ilardi et al., would not produce irritation.

Applicant argues, "All examples of Shana's contain at least 20% surfactant". This argument is not persuasive. The Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707

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F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). In the instant case, Shana teaches that her nonionic surfactants can comprise as little as 1% of her composition.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw



SREENI PADMANABHAN
PRIMARY EXAMINER

9/4/03